

## REMARKS

### Interview request

Applicants respectfully request a telephonic interview after the Examiner has reviewed the instant response and amendment. Applicants request the Examiner call Applicants' representative, as noted below.

### Status of the Claims

#### *Pending claims*

Claims 1, 46, 56 to 58, 61, 64, 66, 68, 70, 73, 125, 126, 130, 131, 133, 135, 137, 138, 140, 157, 161, 169, 171, 218, 221, 225, 229, 231 to 234, 236, 241, 262, 265, 269 and 271 to 273, are pending.

#### *Claims added*

New claim 274 is added. According, after entry of this amendment, claims 1, 46, 56 to 58, 61, 64, 66, 68, 70, 73, 125, 126, 130, 131, 133, 135, 137, 138, 140, 157, 161, 169, 171, 218, 221, 225, 229, 231 to 234, 236, 241 and 271 to 274, are pending.

### Telephonic Interview of October 08, 2008

Applicants thank Examiner Raghu for the helpful telephonic interview of October 8, 2008, with Lynn Linkowski, an Agent of Record. In brief summary, during the interview, the issue of an incorrect sequence listing submission was discussed. As suggested by the Examiner, Applicants have included with the present response, the correct sequence listing, along with details regarding the error. Applicants thank the Examiner for agreeing to search the correct sequence.

### Outstanding Objections and Rejections to the Claims

Claims 1, 46, 56, 57, and 133 are objected to for informalities. Claims 1, 46, 56-58, 61, and 133 are rejected under 35 U.S.C. § 112, first paragraph enablement and written description. Claims 1, 46, 56-58, and 61 are rejected under 35 U.S.C. § 102(b). Claims 1, 46, 56-58, 61, and 133 are rejected under 35 U.S.C. § 103(a).

Support for the claim amendments

The specification sets forth an extensive description of the invention in the amended claims. For example, support for a drilling process can be found on in the specification *inter alia* on page 49 of the published US application (2006-0294620), paragraph [0358], last sentence; "The amylases of the present invention can be used in the initial stages (liquefaction) of starch processing, in wet corn milling, in alcohol production, in the textile industry for starch desizing, in baking applications, in the beverage industry, in oilfields in drilling processes; in inking of recycled paper; and in animal feed."

Priority

Applicants confirm acknowledgment of the priority made by the examiner.

Information Disclosure Statement

Applicants thank the Examiner for his consideration of the Information Disclosure Statement (IDS) submitted on 08/04/2005.

Abstract

The Office objected to the Abstract of the disclosure and requested correction because the Abstract should be on a separate sheet of paper. However, applicants believe that the requirement for correction of the Abstract is improper. This application is a U.S. National Stage Application, thus the Office should receive documents from the International Bureau including the Publication of the International Application that contains a cover page with the reproduced abstract of the disclosure for this application. Furthermore, the abstract communicated to the Office by the International Bureau is in accordance with the law and the request for correction by the Examiner should be withdrawn. See MPEP § 1893.03(e)(I):

The abstract is reproduced on the cover page of the publication, even though it appears on a separate sheet of the international application in accordance with PCT Rule 11.4(a). The requirement of 37 CFR 1.52(b) that the abstract "commence on a separate physical sheet or electronic page" does not apply to the copy of the published international application communicated to the designated Offices by the International Bureau under PCT Article 20. Accordingly, it is improper for the examiner of the U.S. national stage application to require the applicant to provide an abstract commencing on a separate sheet if the abstract does not appear on a

separate sheet in the publication of the international application. Unless the abstract is properly amended under the U.S. rules during national stage processing, the abstract that appears on the cover page of the published international application will be the abstract published by the USPTO under 35 U.S.C. 122(b) and in any U.S. patent issuing from the application.

#### Sequence Listing Error

After reviewing the instant Office Action and the file history for this patent application, Applicants discovered that an incorrect sequence listing was inadvertently submitted to the USPTO and subsequently used as the basis for the search of claims directed to the elected SEQ ID NO:7.

The instant application is a National Phase (371) application based on PCT Application No. PCT/US2003/033150 (published as WO 2004/042006). The PCT publication correctly shows a total of 16 sequences in the sequence listing, with the correct version of SEQ ID NO:7 having 1866 nucleotides (see page 49 and the sequence listing of the published PCT application). A search of PAIR shows a sequence listing filed on April 26, 2005 - this is the correct sequence listing with 16 sequences and the version of SEQ ID NO:7 having 1866 nucleotides. Subsequently, on June 21, 2006, in response to the Notice of Missing Requirements, an incorrect sequence listing (one that belonged to an entirely different patent application and therefore, discloses different enzymes) was inadvertently submitted. The incorrect sequence listing has a total of 24 sequences and has a version of SEQ ID NO:7 with 2346 nucleotides. As such, when Applicants elected SEQ ID NO:7 in response to the Restriction Requirement, the wrong SEQ ID NO:7 (2346 nucleotides) was searched.

Since the sequence listing that was originally filed with parent PCT application and also with the priority application (US Provisional Application No. 60/423,626) is correct – that is that it provides the correct SEQ ID NO:7 (1866 nucleotides) – no new matter is introduced with the substitute sequence listing filed herewith. Applicants respectfully request that a new search and examination be performed on the correct SEQ ID NO:7.

Elections/Restrictions

Summary of Group and Sequence Restriction Requirements, Elections and Traversal

In response to the Restriction Requirement of January 18, 2008, Applicants elected Group I, drawn to, inter alia, polynucleotides, probes, vectors, host cells, methods of making and nucleic acid arrays, with traverse. In response to the sequence-base restriction requirement, Applicants elected the polynucleotide of SEQ ID NO:7; noting that SEQ ID NO:8 is encoded e.g., by SEQ ID NO:7, with traverse.

In view of the sequence listing issue described above, Applicants respectfully request that Examiner reconsider the finality and withdrawal of the Group and the sequence restriction requirement. Applicants respectfully aver that after entry of the instant amendment, acceptance of the substitute sequence listing and subsequent search and examination of the correct SEQ ID NO:7, all claims will be linked as to form a single general inventive concept, i.e., all claims will have the requisite "unity of invention".

This application is a national phase application claiming benefit of priority under 35 U.S.C. §371 to Patent Convention Treaty (PCT) International Application Serial No: PCT/US2003/033150, filed October 15, 2003; published as WO 2004/042006, on May 21, 2004.

Because this application is a §371 national phase application restriction is evaluated under:

*PCT RULE 13*  
*Unity of Invention*

*PCT RULE 13.1.*  
*Requirement*

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

*PCT RULE 13.2.*

*Circumstances in Which the Requirement of Unity of Invention Is To Be Considered Fulfilled*  
Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Further direction is provided in MPEP 1893.03(d) (MPEP Eighth Ed, Rev. 3, Aug. 2005, page 1800-200, 201):

**MPEP 1893.03(d) Unity of Invention [R-2] - 1800 Patent Cooperation Treaty**

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key.

Accordingly, in light of the instant amendment, Applicants respectfully request the Patent Office to rejoin all Groups and all claims pending after entry of the instant amendment, including claims from Groups II to XXII to the elected Group I.

Applicants respectfully aver that after entry of the instant amendment all pending claims in this application will satisfy PCT Rule 13.2 in that they will share the novel inventive concept based use of a genus of polypeptides as exemplified by SEQ ID NO:8, encoded e.g., by the genus of nucleic acids as exemplified by SEQ ID NO:7. Accordingly, in light of the instant amendment, all claims in Groups II to XXII can be properly added back to the elected Group I.

Claim Objections

Claims 1, 46, 56, 57, and 133 are objected to for informalities. The instant amendment addresses these issues.

Issues under 35 U.S.C. §112, first paragraph

Enablement

Claims 1, 46, 56-58, 61, and 133 are rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the enablement requirement. As described above, the search performed by the Office was on the incorrect version of SEQ ID NO:7. Applicants respectfully request that the issue of enablement be held in abeyance pending entry of the instant amendment, the outcome of the search and examination of the originally filed (correct) version of SEQ ID NO:7 (1866 nucleotides).

Issues under 35 U.S.C. §112, first paragraph

Written Description

Claims 1, 46, 56-58, 61, and 133 are rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. As described above, the search performed by the Office was on the incorrect version of SEQ ID NO:7. Applicants respectfully request that the issue of written description be held in abeyance pending entry of the instant amendment, the outcome of the search and examination of the originally filed (correct) version of SEQ ID NO:7 (1866 nucleotides).

Issues under 35 U.S.C. §102(b)

Claims 1, 46, 56-58, and 61 are rejected under 35 U.S.C. § 102(b), as being allegedly anticipated by Hulsmann. As described above, the search performed by the Office was on the incorrect version of SEQ ID NO:7. Applicants respectfully request that the rejection under 102(b) be held in abeyance pending entry of the instant amendment, the outcome of the search and examination of the originally filed (correct) version of SEQ ID NO:7 (1866 nucleotides).

Issues under 35 U.S.C. §103(a)

Claims 1, 46, 56-58, 61, and 133 are rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over Hulsmann. Applicants respectfully request that the rejection under 103(a) be held in abeyance pending entry of the instant amendment, the outcome of the search and examination of the originally filed (correct) version of SEQ ID NO:7 (1866 nucleotides).

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CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully aver that the Examiner can properly withdraw the objections and the rejections of the pending claims under 35 U.S.C. § 112, first paragraph, 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a). Applicants respectfully submit that after entry of the instant amendment all claims pending in this application will be in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. **564462003900**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

As noted above, Applicants have requested a telephone conference with the undersigned representative to expedite prosecution of this application. After the Examiner has reviewed the instant response and amendment, please telephone the undersigned at 858 720-5133.

Dated: October 29, 2008

Respectfully submitted,

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